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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/680,079      | 10/07/2003  | Kwan-Ho Chan         | CHAN-33 CON         | 9937             |

7590 08/07/2006  
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EXAMINER

WOO, JULIAN W

ART UNIT PAPER NUMBER

3731

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |               |  |
|------------------------------|-----------------|---------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |  |
|                              | 10/680,079      | CHAN, KWAN-HO |  |
|                              | Examiner        | Art Unit      |  |
|                              | Julian W. Woo   | 3731          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 8, 17, 19-21, 23, 31, 32 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 17, 19-21, 23, 31, 32 and 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 31, 32, 38, and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 31 line 4, "the exposed surface" lacks antecedent basis. In base claim 38, line 13, "the recess planar surface" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8, 20, 23, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Violante (3,840,017). Violante discloses, at least in figures 1 and 2, a surgical apparatus for delivering and retrieving suture (32), where the apparatus includes a cannula (20) having a distal end and a proximal end and a lumen extending therebetween; a handle (10) having a distal end and a proximal end, a passageway (22) extending through at least a portion of the handle, and an exposed surface with a platform (28) disposed between the passageway and the distal end of the handle, where the proximal end of the cannula is attached to the handle and the lumen is in

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communication with the exposed surface of the handle, where the exposed surface is adapted to support a suture extending through the handle, where the passageway is provided with an unobstructed opening at the handle proximal end, where the handle excludes a spool for containing suture (i.e., the handle includes a removable reel as an optional means for guiding suture into the handle), and where the distal end (42) of the cannula is configured to drive a suture against tissue without severing the suture.

5. Claims 31, 38, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Hutterer et al. (4,641,652). Hutterer et al. disclose, at least in figures 1-5, a surgical apparatus for delivering and retrieving suture, where the apparatus includes a passer assembly (fig. 1) and a puller assembly (fig. 2), where the passer assembly includes a handle (3) and a cannula (2), where the handle comprises an elongated body having a passageway extending distally from a suture entryway axially disposed at a proximal end of the body, a recess (9) in the body, and a nose portion (see fig. 3) extending distally of the recess and defining a bore (8a) in communication with the passageway and the recess surface, where the cannula comprises an elongated tubular member defining a lumen (8) aligned with the bore of the nose portion, where the proximal end of the cannula is disposed in the nose portion of the body, where the puller assembly or loop retriever (14) comprises a shaft (13) and a movable suture engager (14), and where a suture and the puller assembly shaft are manually engageable and movable by an operator at the recess surface (see fig. 5).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Violante (3,840,017). Violante discloses the invention substantially as claimed, but does not disclose that the exposed surface ranges from about 3/8 to about 3 1/2 inches in length and does not disclose that the handle has a generally triangular, transverse cross-section. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to size the exposed surface in the range as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. With respect to the limitation of the handle having a generally triangular, transverse cross-section: It would have obvious to one having ordinary skill in the art at the time the invention was made to shape the handle as claimed, since it

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has been held to be a matter of obvious design choice and within the general skill of a worker in the art (as the applicant has also admitted) to shape the handle according to its intended use.

8. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hutterer et al. (4,641,652) in view of Goldrath (5,330,488). Hutterer et al. disclose the invention substantially as claimed, but do not disclose a puller assembly that is a hook retriever. Goldrath teaches, in col. 5, lines 42-48, a puller assembly that can be a loop retriever or a hook retriever, among other configurations. Thus, it would have been a matter of obvious design choice to configure the puller assembly of Hutterer et al. as a loop retriever or a hook retriever. The choice would be dependent upon a user's desired performance features for a retriever, and most important, whether the retriever is able to capture suture.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson (4,779,616), Garman (5,499,991), Burkhart et al. (5,681,333), Reimels et al. (6,022,360), and Marshall et al. (6,045,561) teach puller assemblies.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julian W. Woo  
Primary Examiner

August 4, 2006